

well-defined pattern. However, the examiner asserts that such deficiency in the Primeaux reference would have been obvious to one of ordinary skill in the art in order to "control the distribution of the impact resistance property that the coating supplies to the surface of the substrate." Official Action, p. 3. Applicant strenuously disagrees with the continuing rejection of the claims

The instant invention is predicated, at least in part, upon the unexpected discovery that materials such as claimed may be used to damp vibration in a substrate. Even accepting, *arguendo*, the examiner's reading of the Primeaux reference as to the composition disclosed therein (which Applicant does not), it is beyond peradventure that such claimed use is itself patentable subject matter; that is, a new use for an obvious--or even a known--composition is patentable. *See* 35 USC § 100(b) ("The term 'process'...includes a new use of a known process, machine, manufacture, composition of matter, or material."). Yet, impliedly accepting that none of the prior art, including Primeaux, teaches the method of Applicant's invention -- that is, the method of damping vibration in a substrate -- the examiner depends instead upon the contention that the coating of Primeaux *inherently* possesses the attributes of attenuating noise, harshness and vibration in order to support the asserted obviousness of Applicant's invention. This sort of inherency argument is, in effect, a denial of the patentability of "new use"-type patents; for if it were the case that the *unknown* properties of old or obvious compounds defeated the patentability of a new use, Section 100(b) of the Patent Act would have no meaning.

Fortunately, however, this is not the case. On the contrary, it is well settled that inherency and obviousness are *separate*, and sometimes mutually exclusive, concepts. See W. L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983). Inherency, for its part, may comprehend that which "is not necessarily known." Obviousness, on the other hand, "*cannot* be predicated on what is unknown." In re Spormann, 150 USPQ 449 (CCPA 1966)(*emphasis added*).

Thus, in rejecting as obvious an invention comprehending a new use, the burden on the Patent Office is "to show a reasonable expectation, or some predictability," in the prior art respecting the claimed use. In re Shetty, 195 USPQ 753 (CCPA 1977). Inherency, when unknown, is legally insufficient in these regards: "[Inherency] is quite immaterial if...one of ordinary skill in the art would not appreciate or recognize the inherent result." *Id.* (quoting In re Naylor, 152 USPQ 108 (CCPA 1966)).

It is therefore inconsequential *if* the composition of Primeaux is identical to, or renders obvious, the composition of Applicant's invention (which point Applicant does *not* concede), and further inherently exhibits, as asserted by the examiner, the attributes of attenuating noise, harshness and vibration, so long as the instantly claimed method of damping vibration in a substrate was not known prior to Applicant's invention.

In light of the foregoing, it also matters not whether one of ordinary skill may have been motivated, as the examiner urges, to apply the coating of Primeaux "in a tight, well-defined manner pattern" (a contention with which Applicant does not, of course, agree), since the purported impetus bears no relation to the use of Applicant's invention,

but instead to the particular application taught by Primeaux; namely, to “control distribution of the impact resistance property...” Official Action, p. 3. Nevertheless, Applicant notes for the record that the examiner’s argued motivation is insufficient to establish a *prima facie* case of obviousness.

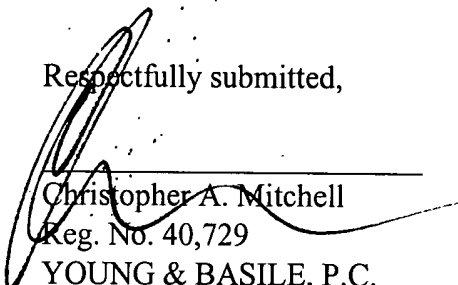
The examiner’s burden in regards to obviousness is to show, *inter alia*, “some reason, suggestion, or motivation in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992). In these regards, Applicant respectfully submits that the prior art nowhere teaches or suggests the desirability of applying the coating of Primeaux “in a tight, well-defined manner pattern.” Nor, Applicant submits, is it legally sufficient or appropriate for the examiner to make the bare, unsubstantiated assertion that such knowledge would have been possessed by one of ordinary skill in the art at the time of Applicant’s invention.

In view of the above arguments, Applicant respectfully submits that the rejections of the remaining dependent claims, including claims 21 and 30-32 over the combination of Primeaux in view of Xiao et al., are rendered moot. This fact notwithstanding, Applicant notes that the art of record, taken alone or in any permissible combination, fails to either anticipate or render obvious the invention of these claims. Should the examiner maintain the rejections to the claims, Applicant reserves the right to place the claims in allowable form, argue the patentability thereof, and/or appeal such rejection.

II. Conclusion

In view of the foregoing, Applicant submits that the claims are in condition for immediate allowance. Of course, the examiner is invited to contact Applicant's undersigned counsel at (734) 662-0270 if he should have any questions respecting this paper, or if a telephonic interview might otherwise expedite the prosecution of this case.

Respectfully submitted,



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DATED: 20 January 2003